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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,559	06/19/2006	Yoshihiro Tani	292366US0PCT	3161
22850	7590	02/15/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LOEWE, ROBERT S	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			02/15/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/583,559

Applicant(s)

TANI ET AL.

Examiner

Robert Loewe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/19/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Nakagawa et al. (WO 2002/81588). For convenience, the English-language equivalent of Nakagawa et al. (US 2004/0125169) will be relied upon.

Claims 1 and 3: Nogami et al. explicitly teaches a process for preparing a coating fluid having all of the process limitations of instant claims 1 and 3 (claim 1 of Nogami et al.). Nogami et al. further teaches components (A), (C) and (D) (2:35-3:4). Nogami et al. does not explicitly

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teach the addition of silicon compound (B) of instant claim 1. However, Nakagawa et al. does teach the addition of silicon compound (B) of instant claim 1 (paragraphs 0059 and 0242). Nogami et al. and Nakagawa et al. are combinable because they are from the same field of endeavor, namely, siloxane-based, water-repellant coatings. At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the perfluorinated alkoxy silanes as taught by Nakagawa et al. (paragraphs 0059 and 0242) into the coating compositions as taught by Nogami et al. and would have been motivated to do so because Nakagawa et al. teaches that perfluorinated alkoxy silanes according to instant claim 1 offer better packing densities and therefore better wear resistance and adhesion (paragraphs 0059 and 0242).

Claim 2: Nogami et al. further teaches the addition of a modifier (E) to the composition having the structural limitations of formula (4) of instant claim 2 (4:52-5:7).

Claim 4: Nogami et al. further teaches the addition of a sol selected from a silica sol, an alumina sol, a titania sol, a zirconia sol, a magnesium fluoride sol, and a ceria sol (5:55-6:8).

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Nakagawa et al. (WO 02/81588). For convenience, the English-language equivalent of Nakagawa et al. (US 2004/0125169) will be relied upon.

Claims 5 and 7: Nogami et al. explicitly teaches a process for preparing a coating film having all of the physical properties and process limitations of instant claims 5 and 7 (claim 1 of Nogami et al.). Nogami et al. further teaches components (A), (C) and (D) (2:35-3:4). Nogami et al. does not explicitly teach the addition of silicon compound (B) of instant claim 1. However,

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Nakagawa et al. does teach the addition of silicon compound (B) of instant claim 5 (paragraphs 0059 and 0242). Nogami et al. and Nakagawa et al. are combinable because they are from the same field of endeavor, namely, siloxane-based, water-repellant coatings. At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the perfluorinated alkoxy silanes as taught by Nakagawa et al. (paragraphs 0059 and 0242) into the coating compositions as taught by Nogami et al. and would have been motivated to do so because Nakagawa et al. teaches that perfluorinated alkoxy silanes according to instant claim 5 offer better packing densities and therefore better wear resistance and adhesion (paragraphs 0059 and 0242).

Claim 6: Nogami et al. further teaches the addition of a modifier (E) to the composition having the structural limitations of formula (4) of instant claim 6 (4:52-5:7).

Claim 8: Nogami et al. further teaches the addition of a sol selected from a silica sol, an alumina sol, a titania sol, a zirconia sol, a magnesium fluoride sol, and a ceria sol (5:55-6:8).

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Nakagawa et al. (WO 02/81588). For convenience, the English-language equivalent of Nakagawa et al. (US 2004/0125169) will be relied upon.

Claims 9 and 11: Nogami et al. explicitly teaches a coating film having all of the physical properties and process steps of instant claims 9 and 11 (claim 1 of Nogami et al.). Nogami et al. further teaches components (A), (C) and (D) (2:35-3:4). Nogami et al. does not explicitly teach the addition of silicon compound (B) of instant claim 1. However, Nakagawa et al. does teach

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the addition of silicon compound (B) of instant claim 1 (paragraphs 0059 and 0242). Nogami et al. and Nakagawa et al. are combinable because they are from the same field of endeavor, namely, siloxane-based, water-repellant coatings. At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the perfluorinated alkoxy silanes as taught by Nakagawa et al. (paragraphs 0059 and 0242) into the coating compositions as taught by Nogami et al. and would have been motivated to do so because Nakagawa et al. teaches that perfluorinated alkoxy silanes according to instant claim 9 offer better packing densities and therefore better wear resistance and adhesion (paragraphs 0059 and 0242).

Claim 10: Nogami et al. further teaches the addition of a modifier (E) to the composition having the structural limitations of formula (4) of instant claim 10 (4:52-5:7).

Claim 12: Nogami et al. further teaches the addition of a sol selected from a silica sol, an alumina sol, a titania sol, a zirconia sol, a magnesium fluoride sol, and a ceria sol (5:55-6:8).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,800,926 in view of Nakagawa et al. (WO 02/81588). Specifically, the instant claims and the claims of US Pat. 5,800,926 are drawn to the same invention. The only difference between the instant claims and the claims of patent '926 is that the instant claims include an additional silicon compound (B) (instant claims 1, 5, and 9). However, Nakagawa et al. teaches the addition of this component to water-resistant silicone-based coatings (paragraphs 0059 and 0242). At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the perfluorinated alkoxy silanes as taught by Nakagawa et al. (paragraphs 0059 and 0242) into the coating compositions as taught by Nogami et al. and would have been motivated to do so because Nakagawa et al. teaches that perfluorinated alkoxy silanes according to instant claim 9 offer better packing densities and therefore better wear resistance and adhesion (paragraphs 0059 and 0242).

#### ***Relevant Art Cited***

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

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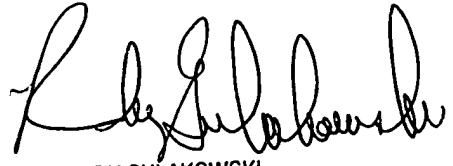
*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSL  
2-Jan-08

  
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